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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,216	09/24/2003	Yasuhiro Yoneda	1422-0603P	1568

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EXAMINER

MARCHESCHI, MICHAEL A

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 08/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/668,216

Applicant(s)

YONEDA ET AL.

Examiner

Michael A. Marcheschi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1 020 501 alone or in view of Liu et al. and/or Ina et al. for the same reasons set forth in the previous office action which are incorporated herein by reference.

New claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1 020 501 alone or in view of Liu et al. and/or Ina et al. The EP reference teaches in section [0055] sizes for the inorganic particles which encompass the claimed sizes.

Claims 1-4 and 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1 036 836 alone or in view of Liu et al. and/or Ina et al. for the same reasons set forth in the previous office action which are incorporated herein by reference.

New claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1 036 836 alone or in view of Liu et al. and/or Ina et al. The EP reference teaches in section [0061] sizes for the inorganic particles which encompass the claimed sizes.

Applicant's arguments filed 8/11/05 have been fully considered but they are not persuasive.

Applicants argue that EP 501 only discloses fumed silica (see examples). The examiner acknowledges what the **examples** define, but the specification discloses a "silica" abrasive and as stated before the recitation of "silica" in general encompasses colloidal silica because a **generic disclosure renders a claimed species prima facie obvious. *Ex parte George* 21**

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USPQ 2d 1057, 1060 (BPAI 1991); *In re Woodruff* 16 USPQ 2d 1934; *Merk & Co. v. Biocraft Lab. Inc.* 10 USPQ 2d 1843 (Fed. Cir. 1983); *In re Susi* 169 USPQ 423 (CCPA 1971). Any argument based on what the examples show is considered a preferred embodiment and as is well known a reference can be used for all it realistically teaches and is not limited to the disclosure in its preferred embodiments (i.e. examples)" See *In re Van Marter*, 144 USPQ 421. Applicants also appear to argue that table 1 shows comparisons between colloidal silica and fumed silica, thus showing a difference between colloidal silica and fumed silica. While not in total agreement, this table might show comparisons between colloidal silica and fumed silica when these are used alone and not when combined with polymer particles. Although fumed silica and colloidal silica might be used alone in the examples and comparative examples, this does not clearly establish that the generalization of silica as defined in section [0053] only relates to fumed silica. The examiner acknowledges the difference between fumed silica and colloidal silica as defined on page 7 of the response but how does this preclude colloidal silica from the reference? In addition, since colloidal silica can be referring to the size of the silica and the abrasive defined in sections [0053] and [0055] of the reference states that silica having a size of 0.01 micron (nm) is used, this can be considered colloidal silica because it is colloidal in nature. Applicants made a conclusion that the silica the EP reference is referring to is fumed silica. The examiner cannot find sufficient, clear and convincing evidence that supports this conclusion.

The examiner has also made an obvious rejection being based on the combination of EP 1 020 501 in view of Liu et al. and/or Ina et al. (why the use of colloidal silica is obvious). Applicants have not clearly responded to this rejection, as applied.

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The examiner also applied a rejection based on the combination of EP 1 036 836 alone or in view of Liu et al. and/or Ina et al. and applicants have not clearly argued this. On page 8 of the response applicants state that the teachings of EP 501 and EP 836 are inconsistent with each other. The examiner is unclear as to this argument because a combination of these references has not been made.

In summary, the EP references alone or in combination with Liu et al. and/or Ina et al. suggest polishing composition comprising polymer particles and colloidal silica particles. The sizes for the individual particles are defined and the sizes fall within the criteria of the instant claims. Applicants have not clearly shown any evidence of unexpected results.

Applicant's amendment necessitated the new ground(s) of rejection (new claims) presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

A reference is good not only for what it teaches but also for what one of ordinary skill might reasonably infer from the teachings. *In re Opprecht* 12 USPQ 2d 1235, 1236 (CAFC 1989); *In re Bode* USPQ 12; *In re Lamberti* 192 USPQ 278; *In re Bozek* 163 USPQ 545, 549 (CCPA 1969); *In re Van Mater* 144 USPQ 421; *In re Jacoby* 135 USPQ 317; *In re LeGrice* 133 USPQ 365; *In re Preda* 159 USPQ 342 (CCPA 1968). In addition, "A reference can be used for all it realistically teaches and is not limited to the disclosure in its preferred embodiments" See *In re Van Marter*, 144 USPQ 421.

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a prima facie case of obviousness, see *In re Malagari*, 182 U.S.P.Q. 549; *In re Wertheim* 191 USPQ 90 (CCPA 1976).

Evidence of unexpected results must be clear and convincing. *In re Lohr* 137 USPQ 548. Evidence of unexpected results must be commensurate in scope with the subject matter claimed. *In re Linder* 173 USPQ 356. The examiner acknowledges the statements made by applicants in the background section (statements referring to the prior art applied), but these statements alone are not sufficient to show patentability. To establish unexpected results over a claimed range, applicants should compare a sufficient number of tests both inside and outside (i.e. as well as the upper and lower limits) the claimed range to show the criticality of the claimed range. *In re Hill* 284 F.2d 955, 128 USPQ 197 (CCPA 1960).

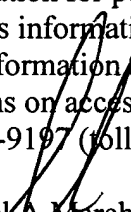
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

8/25/05
MM


Michael A. Marcheschi
Primary Examiner
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